

REMARKS

Included herein is a request for a three-month extension of time along with the appropriate fee.

In the Office Action mailed 1/14/2005, Claims 1-4 and 11-14 were rejected as being anticipated by the prior art under 35 U.S.C. §102(b). Claim 15 was rejected as being obvious over the prior under 35 U.S.C. § 103. Claims 1-16 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 5-10 and 16 were objected to as being dependent upon rejected base claims, but were otherwise indicated as being allowable.

In response, Applicant has made amendment to cure the §112 indefiniteness problems, although Applicant has not amended Claim 1 for this purpose, but does respond to the Examiner's question by indicating that there is no positive recitation of the wall and enclosure, but rather that these are non-limiting preambular recitations provided to give the claimed invention an context within which to be interpreted. The wall and enclosure, therefore, are not elements of the claimed invention.

As for the prior art rejections of the claims, Applicant has made amendment to independent Claims 1 and 11 to more clearly recite the features of the previously-recited "elastic strut member(s)." It is Applicant's hope that these additional limitations, along with the Examiner's review of Figure 4B as originally filed, will clarify the distinctions between the cited prior art and Applicant's claimed invention. As such, Applicant now respectfully traverses these rejections for the reasons cited below.

Patentability of Independent Claims 1 and 11, and claims Dependent Thereon

Claims 1- 4 and 11-14 were rejected under 35 U.S.C. §102(b) as being anticipated by Johnson, U.S. Patent No. 4,702,036. Applicant respectfully traverses this rejection for the reason set forth below after a discussion of the disclosures of this reference.

Johnson, U.S. Patent No. 4,702,036

Johnson is a "Doorway Safety Gate Apparatus." Focusing on Applicant's claimed elements that Applicant believes are lacking in this reference, Johnson discloses a pair of "upper anchors 4 and 4'" "to securely fasten [the gate assembly] to doorway pillar frame." Review of Johnson's Figures 1, 2 and 15 reveals that elements 4 and 4' are simply straps wrapped around the pillars 1. Clearly, the straps 4 and 4' are not "elastic," nor do they include "resilient members" such as those depicted in Applicant's Figure 4B. Consequently, at least the limitations of Claims 1 and 11 related to the "elastic strut members interconnecting said hinge posts to an external wall, each said elastic strut member comprising a base portion fixedly attached to the wall and a resilient member interconnecting said base portion and said hinge post" are not disclosed or hinted at by Johnson.

Since Johnson fails to disclose each and every element of Applicant's claimed invention (i.e. of Claims 1 and 11 and the claims dependent thereon), the prima facie case of anticipation has not been made, and this ground for rejection must be withdrawn.

Anticipation Standard

By combining the elements of various well-known decisions, one can see that a prima facie case of anticipation is established only when the Examiner provides:

1. a single reference¹
2. that teaches or enables²
3. each of the claimed elements (arranged as in the claim)³
4. expressly or inherently⁴
5. as interpreted by one of ordinary skill in the art.⁵

Patentability of Dependent Claim 15

This claim stands rejected as being obvious under 35 U.S.C. §103(a) over the combination of *Johnson* and *Gandara*. Applicant respectfully traverses this rejection for the reason set forth below after a discussion of *Gandara* disclosures.

Gandara, U.S. Patent No. 5,494,261

Gandara discloses a "Corrugated Privacy Fence and Method of Fabrication Thereof." Nothing in *Gandara* discloses or hints at Applicant's claimed elastic strut members interconnecting said hinge posts to an external wall of claim 11 (and Claim 15 through dependency).

¹ *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

² *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986) (citing *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (CCPA 1964)).

³ *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ at 485.

⁴ *Continental Can Co. USA v. Monsanto Co.*, 20 USPQ 2d at 1749-50.

⁵ *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

Johnson, as discussed above, also fails to disclose or hint at Applicant's claimed elastic strut members. Furthermore, Johnson actually teaches away from such an elastic connection by disclosing rigid straps 4 and 4' making such connection.

Since Applicant's claimed elastic strut members are not taught or suggested by the cited references, the prima facie case of obviousness has not been made, and this ground for rejection must be withdrawn.

Obviousness Standard

1. one or more references⁶
2. that were available to the inventor⁷
3. where the reference(s) teach⁸
4. a suggestion to combine or modify the reference(s)⁹
5. the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.¹⁰

⁶ *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

⁷ See *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986).

⁸ *Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986) (citing *In re Brown*, 329 F.2d 1006, 1011, 141 USPQ 245, 249 (CCPA 1964)).

⁹ *In re Lahu*, 747 F.2d 703, 223 USPQ 1257, 1258 (Fed. Cir. 1984).

¹⁰ *Rockwell Int'l Corp. v. United States*, 147 F.3d 1358, 47 USPQ 2d 1027, 1033 (Fed. Cir. 1998).

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests that the application be reconsidered, the claims be allowed, and the case passed to issue.

Respectfully submitted,

STEINS & ASSOCIATES



Karl M. Steins
Registration No. 40,186
2333 Camino del Rio South
Suite 120
San Diego, California 92108
Telephone: (619) 692-2004
Facsimile: (619) 692-2003